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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/680,980   | 10/08/2003  | Werner Knebel        | 5005.1061                  | 6488             |
| 23280  | 7590        | 05/31/2005           |                            |                  |
| DAVIDSON, DAVIDSON & KAPPEL, LLC<br>485 SEVENTH AVENUE, 14TH FLOOR<br>NEW YORK, NY 10018 |             |                      | EXAMINER<br>FINEMAN, LEE A |                  |
|  |             |                      | ART UNIT                   | PAPER NUMBER     |
|  |             |                      | 2872                       |                  |

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/680,980

Applicant(s)

KNEBEL, WERNER

Examiner

Lee Fineman

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2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/8/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I in the reply filed on 3 March 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 3-5, 7 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 8-11 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Knebel et al. US 2002/0020800 A1.

Regarding claims 1, 6, 8-9 and 17, Knebel et al. disclose in fig 2 a confocal scanning microscope (page 5, section [0056]) comprising a light source (3 and 4) that emits an illuminating light beam (on 5), for illumination of a sample (1), that extends along an illumination beam path (5) and can be guided over and/or through the sample (1) using a beam

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deflection device (12); a detector (6) that receives detection light (on 7), proceeding from the sample (1), that extends along a detection beam path (7); a light source (8) that emits a manipulating light beam (on 9); and a mirror (21) that is at least partially transparent to the illuminating light beam (page 5, section [0059], lines 3-7), which can be introduced in guided fashion into the illumination beam path (fig. 2, at least in so far as it was guided into place during assembly), whereby the mirror directs the manipulating light beam via the beam deflection device onto the sample (see page 2, section [0027], lines 7-8, if one beam deflection device is used for the beam combination, then it will also direct the manipulation light onto the sample); and wherein the illuminating light beam and the manipulating light beam can be guided over and/or through the sample using the beam deflection device (see page 2, section [0027], lines 7-8, if one beam deflection device is used for the beam combination, then it will also guide both light beams over and/or through the sample).

Regarding claims 10-11, Knebel et al. further disclose wherein the illuminating light beam (on 5) can be guided on a scanning track (by 12) over and/or through the sample (1); and wherein the manipulating light beam can be guided on the scanning track over and/or through the sample (see page 2, section [0027], lines 7-8, if one beam deflection device is used for the beam combination, then it will also guide the manipulation light beam on the same scanning track over and/or through the sample).

Regarding claim 13, Knebel et al. further disclose wherein the scanning track is largely meander-shaped or sinusoidal (see fig. 4).

Regarding claims 14-16, Knebel et al. further disclose wherein the manipulating light beam at least partially bleaches the sample (page 2, section [0023], lines 18-19); wherein the

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manipulating light beam cuts the sample (page 2, section [0023], lines 17-18); and wherein the manipulating light beam acts as an optical tweezers (page 2, section [0023], lines 16-17).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knebel et al. in view of Batchelder et al. US 5,689,333.

Knebel et al. disclose the claimed invention except for wherein the mirror is a hinged mirror. Batchelder et al. teach in fig. 1 a microscope with mirrors (46, 74 or 76) which move in and out of the beam path to direct light in the system (column 2, lines 54-57 and column 4, lines 22-23) and which can be hinged (column 4, lines 41-42). It would have been obvious to one of ordinary skill in the art to make the mirror of Knebel et al. a hinged mirror which moves in and out of the beam path as suggested by Batchelder et al. to permit ordinary use of the microscope without the second light beam (Batchelder, column 2, lines 54-57).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liu, US 6,159,749 and Wendenburg et al., US 6,850,363 B1 disclose optical manipulation microscope systems.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LAF

May 26, 2005

  
MARK A. ROBINSON  
PRIMARY EXAMINER